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10/510,917

10/12/2004

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EXAMINER

WRIGHT, PATRICIA KATHRYN

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

09/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/510,917 | Applicant(s) AMANO ET AL. | |
| | Examiner P. Kathryn Wright | Art Unit 1797 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-26, 34-36, 44 and 45 is/are rejected.
- 7) ☐ Claim(s) 27-33, 37-43, 46-50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This action is in response to papers filed June 06, 2008 in which claims 24-37 and 39-50 were amended.

The amendments have been thoroughly reviewed and entered. Any objection/rejection not repeated herein have been withdrawn by the Office. New grounds for rejection, necessitated by the amendments (e.g., addition of ejecting port located in the cartridge wall...), are discussed.

Claims 1-50 are pending.

Election/Restrictions

2. Applicant's Response fails to affirm the election of Group II. Since applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The requirement is deemed proper and is therefore made FINAL.
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

4. The drawings were received on June 06, 2008. These drawings are acceptable.

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the claims now recite "driving mechanism" instead of "sensor sending out mechanism". The phrase "driving mechanism" does not find support in the specification as originally filed.

The rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1). The Examiner recommends Applicant change "driving mechanism" back to "sensor sending out mechanism".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 24-26, 34-36, and 44-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Amano (JP Pub. No. 2001-141686).

Amano teaches a biosensor dispensing device comprising a biosensor cartridge 3 for storing a stacked plurality of biosensors 6 and including sensor ejecting means 4a-c for ejecting a biosensor from the cartridge via a sensor ejecting port 3d (see Fig. 3). The sensor ejecting port 3d is located in a wall of the cartridge facing tips of such biosensors, which port is closed except when such biosensors are being ejected. Note that the claim does not positively recite a means for closing the port. Applicant is reminded that an apparatus claim must be structurally distinguishable from the prior art (see MPEP 2114).

The Amano device also includes a biosensor dispensing device body 1 comprising a cartridge storing chamber for detachably holding said biosensor cartridge (see Fig. 1).

Amano teaches a driving mechanism for driving the sensor ejecting means 4a-c in the biosensor cartridge. The driving mechanism reads on the pulleys which rotate rollers 4a-c (sensor ejecting means 4a-c) in Fig. 1. Amano also teaches a sensor conveying mechanism 8 for conveying an ejected biosensor from the sensor ejecting port to a predetermined test position (see Figs. 1 and 8 and paragraph [0024] of English translation). Lastly, Amano teaches an operating part (reads on controller 12) located outside the device body (see Fig. 1), for the operating the driving mechanism, thereby ejecting a biosensor from the sensor ejecting port.

With respect to claim 25 Amano teaches a conducting means (31) for connecting electrodes on the biosensor in such test position and for transmitting electrical data from the biosensor to an electrical circuit within the body (see paragraph [0032]-[0034]).

Regarding claim 26, the biosensor dispensing device of Amano includes a display unit (reads on indicator 12c). The display is located on an exterior surface of the device body for receiving electrical data and displays data from the electrical circuit (see paragraph [0030] and [0056], see Fig. 1).

Claims 34 and 36 are directed to the manner in which the dispensing device is operated. These limitations do not impart patentability to the claims because they are directed to how the device functions; whereas, patentability in an apparatus claim is determined by the structure of the device.

As to claim 35, Amano inherently teaches a power source (means for powering).

Regarding claims 44-45, the cutter 37 of Amano can act as a latch mechanism (i.e., latch projections) for locking the operating part in place when the biosensor is in the test position.

Allowable Subject Matter

8. Claims 27-33, 37-43 and 46-50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter. As discussed above, Amano does teach a biosensor dispensing device comprising a cartridge storing chamber detachably holding a biosensor cartridge for storing a plurality of biosensors in a case in a stacked manner and including sensor send-out means for sending out the biosensor in the case one by one and discharging the biosensor from a sensor ejecting port opened at the case. The Amano device includes a sensor sending out mechanism for driving the sensor send-out means in the biosensor cartridge, wherein the cartridge storing chamber can hold the biosensor cartridge including a cylindrical rotating member and a sliding member sliding with the rotation of the rotating member to push the rear end of the biosensor as sensor send-out means; the sensor sending out mechanism includes a rotating means for rotating the rotating member of the biosensor cartridge, and the operating part is configured so as to move the sensor sending out mechanism with a forefinger while gripping the body with one hand.

However none of the known prior art, including Amano, teaches or suggests the specific limitations set forth in claims 27 or 46.

Response to Arguments

9. Applicant's arguments with respect to claims 24-50 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. No claims are allowed.
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
12. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is (571)272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1797

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

pkw

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797